

REMARKS

The enclosed remarks address the Office Action mailed October 14, 2010 (hereinafter "Office Action"). Applicants would like to thank the Examiner for a timely and thorough review of the above-referenced patent application. It is respectfully submitted that in light of the remarks below, all of the claims are now in condition for allowance.

Rejection of Claims 1 and 20 under 35 U.S.C. § 103(a) – Constantin, Daniel, and Beshai

Claims 1 and 20 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,198,725 to Constantin et al. (hereinafter "Constantin") in view of U.S. Patent No. 5,726,985 to Daniel et al. (hereinafter "Daniel") and U.S. Patent Application Publication No. 2003/0189938 to Beshai et al. (hereinafter "Beshai"). Applicants respectfully traverse.

For the Patent Office to reject a claim under 35 U.S.C. § 103(a), the Patent Office must show where each and every element of the claim is taught or suggested in the prior art. MPEP § 2143. If the Patent Office cannot establish obviousness, Applicants are entitled to a patent. 35 U.S.C. §§ 102, 103. Certain references are disqualified from the field of available prior art. Specifically, 35 U.S.C. § 103(c)(1) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Beshai was filed on April 9, 2003, after Applicants' priority date. Likewise, Beshai was published on October 9, 2003, again after Applicants' priority date. Beshai claims priority to U.S. Patent No. 6,570,872 (the "'872 Patent"), which issued on May 27, 2003, again after Applicants' priority date. The '872 Patent was filed on April 6, 1999. Thus, the only provision of 35 U.S.C. § 102 under which Beshai might qualify as prior art is § 102(e). However, the present application was, at the time of filing, assigned to Nortel Networks Corporation as evidenced by the assignment recorded at reel/frame 010612/0692. When filed, Beshai was assigned to Northern Telecom Limited (see assignment reel/frame 009890/0752, dated 04/06/1999) which changed its name to Nortel Networks Corporation (see change of name

reel/frame 010567/0001, dated 12/23/1999), and which changed its name again to Nortel Networks Limited (see change of name reel/frame 011195/0706, dated 08/30/2000). Thus, at the time of invention, the subject matter of the Beshai reference and the claimed invention were owned by Nortel Networks Corporation (or at least under an obligation of assignment to Nortel Networks Corporation). Thus, under 35 U.S.C. § 103(c)(1), Beshai is not prior art.

The Patent Office admits that Constantin in view of Daniel does not teach or suggest “reconfiguring a switch matrix within the network.” Office Action of October 14, 2010, p. 3. The Patent Office relies on Beshai to provide the missing claim element. However, as noted, Beshai is not prior art and cannot be so used. Since the remaining references admittedly do not teach or suggest all the claim elements, the Patent Office has not established obviousness, and claims 1 and 20 are allowable.

Claims 3-15 depend from claim 1 and are allowable at least for the same reasons.

Claims 21-33 depend from claim 20 and are allowable at least for the same reasons.

Rejection of Claim 2 under 35 U.S.C. § 103(a) –
Constantin, Daniel, Chuah, and Thorson

Claim 2 stands rejected under 35 U.S.C. § 103(a) over Constantin in view of Daniel, U.S. Patent Application Publication No. 2003/0214928 to Chuah et al. (hereinafter “Chuah”), and U.S. Patent No. 4,440,986 to Thorson (hereinafter “Thorson”). Applicants respectfully traverse. The standards for establishing obviousness are set forth above.

The Patent Office continues to reject claim 2 over Chuah. However, Applicants’ previous amendment made the use of Chuah superfluous. That is, the Patent Office was using Chuah to show “reducing the number of channels in a network based on the conditions of a channel....” See Office Action of July 7, 2010, p. 3. That claim element was eliminated in the response filed September 7, 2010. If the Patent Office intended to keep Chuah as the reference, then the Patent Office has not shown “reconfiguring a switch matrix within the PBX network” as recited in claim 2. That is, the Patent Office admits that Constantin and Daniel do not teach or suggest the element and has pointed to nothing in Chuah or Thorson that cures this deficiency. Since the Patent Office has not shown a claim element, the Patent Office has not established obviousness for claim 2.

If the Patent Office meant to use Beshai in place of Chuah, the rejection still fails because, as explained above, Beshai is not prior art. Either way, the Patent Office has not established obviousness, and claim 2 is allowable.

Claim 34 depends from allowable claim 2 and is allowable for the same reasons.

**Rejection of Claims 3, 6-8, 21, and 24-26 under 35 U.S.C. § 103(a) –
Constantin, Daniel, Chuah, and Yamato**

Claims 3, 6-8, 21, and 24-26 stand rejected under 35 U.S.C. § 103(a) over Constantin in view of Daniel and Chuah, as applied to claim 1 or 20 above, in further view of U.S. Patent No. 5,694,390 to Yamato et al. (hereinafter "Yamato"). Applicants respectfully traverse. The standards for establishing obviousness are set forth above.

Applicants initially note that the Patent Office continues to rely on Chuah in its analysis. However, Applicants' previous amendments overcame the rejections based on Chuah and made the Patent Office rely on Beshai for the missing element in the independent claims. Since the combination of Constantin, Daniel, and Chuah does not teach or suggest "reconfiguring a switch matrix within the network..." and since Beshai (whether cited or not) is not prior art, the Patent Office has not established obviousness for independent claims 1 and 20. The Patent Office points to nothing in Yamato that cures the deficiencies of the underlying combination. Thus, the Patent Office has not established obviousness and claims 3, 6-8, 21, and 24-26 are allowable.

**Rejection of Claims 4, 5, 22, and 23 under 35 U.S.C. § 103(a) –
Constantin, Daniel, Chuah, and Campbell**

Claims 4, 5, 22, and 23 stand rejected under 35 U.S.C. § 103(a) over Constantin in view of Daniel and Chuah, as applied to claim 1 or 20 above, in further view of U.S. Patent Application Publication No. 2003/0140159 to Campbell et al. (hereinafter "Campbell"). Applicants respectfully traverse. The standards for establishing obviousness are set forth above.

Applicants initially note that the Patent Office continues to rely on Chuah in its analysis. However, Applicants' previous amendments overcame the rejections based on Chuah and made the Patent Office rely on Beshai for the missing element in the independent claims. Since the combination of Constantin, Daniel, and Chuah does not teach or suggest "reconfiguring a switch matrix within the network..." and since Beshai (whether cited or not) is not prior art, the Patent

Office has not established obviousness for independent claims 1 and 20. The Patent Office points to nothing in Campbell that cures the deficiencies of the underlying combination. Thus, the Patent Office has not established obviousness and claims 4, 5, 22, and 23 are allowable.

**Rejection of Claim 34 under 35 U.S.C. § 103(a) –
Constantin, Daniel, Chuah, Thorson, and Campbell**

Claim 34 stands rejected under 35 U.S.C. § 103(a) over Constantin in view of Daniel, Chuah and Thorson, as applied to claim 2 above, in further view of Campbell. Applicants respectfully traverse. The standards for establishing obviousness are set forth above.

As explained above, the Patent Office has not established obviousness for claim 2. The addition of Campbell does not cure the deficiencies of the underlying rejection, and thus, claim 34 is also allowable.

**Rejection of Claims 9-13 and 27-31 under 35 U.S.C. § 103(a) –
Constantin, Daniel, Chuah, Yamato, and Geagan**

Claims 9-13 and 27-31 stand rejected under 35 U.S.C. § 103(a) over Constantin in view of Daniel, Chuah and Yamato, as applied to claim 8 or 26 above, in further view of U.S. Patent No. 6,263,371 to Geagan, III et al. (hereinafter "Geagan"). Applicants respectfully traverse. The standards for establishing obviousness are set forth above.

Applicants initially note that the Patent Office continues to rely on Chuah in its analysis. However, Applicants' previous amendments overcame the rejections based on Chuah and made the Patent Office rely on Beshai for the missing element in the independent claims. Since the combination of Constantin, Daniel, Chuah, and Yamato does not teach or suggest "reconfiguring a switch matrix within the network..." and since Beshai (whether cited or not) is not prior art, the Patent Office has not established obviousness for independent claims 1 and 20. The Patent Office points to nothing in Geagan that cures the deficiencies of the underlying combination. Thus, the Patent Office has not established obviousness and claims 9-13 and 27-31 are allowable.

**Rejection of Claims 14 and 32 under 35 U.S.C. § 103(a) –
Constantin, Daniel, Chuah, Yamato, Geagan, and Thorson**

Claims 14 and 32 stand rejected under 35 U.S.C. § 103(a) over Constantin in view of Daniel, Chuah, Yamato, and Geagan, as applied to claim 14 or 29 above, in further view of Thorson. Applicants respectfully traverse. The standards for establishing obviousness are set forth above.

Applicants initially note that the Patent Office has apparently misstated the rejection analysis by stating that claim 14 is rejected under the references as applied to claim 14 above. However, the Patent Office has not previously rejected claim 14. As claim 14 depends from claim 13 and claim 32 depends from claim 31, Applicants proceed as if the Patent Office had stated “as applied to claim 13 or 31 above, in further view of Thorson.” If this interpretation is incorrect, Applicants request clarification from the Patent Office as to what was intended.

Applicants note that the Patent Office continues to rely on Chuah in its analysis. However, Applicants’ previous amendments overcame the rejections based on Chuah and made the Patent Office rely on Beshai for the missing element in the independent claims. Since the combination of Constantin, Daniel, Chuah, Yamato, and Geagan does not teach or suggest “reconfiguring a switch matrix within the network...” and since Beshai (whether cited or not) is not prior art, the Patent Office has not established obviousness for independent claims 1 and 20. The Patent Office points to nothing in Thorson that cures the deficiencies of the underlying combination. Thus, the Patent Office has not established obviousness and claims 14 and 32 are allowable.

Conclusion

For at least the foregoing reasons, Applicants respectfully submit that claims 1-15 and 20-34 of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner Harper is encouraged to contact Applicants’ undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

No fees are believed to be due in connection with this Reply. However, the Office is authorized to charge any fees that may be necessitated by this Reply to Deposit Account No. 50-1732.

Application Serial No.: 09/475,269
Reply to Office Action mailed October 14, 2010

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Taylor M. Davenport". The signature is fluid and cursive, with the first name "Taylor" written in a larger, more prominent script than the last name "Davenport".

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